10-02-06

AF/ 2136 #

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(OIPE SEP 28 2006 stamp)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Rajasekhar Abburi   **Confirmation No.:** 1941

Application No.: 09/892,318   **Group Art Unit:** 2136

Filing Date: June 27, 2001   **Examiner:** Eleni A. Shiferaw

For: Enforcement Architecture And Method For Digital Rights Management System For Roaming A License To A Plurality Of Users

EXPRESS MAIL LABEL NO: EV817341425US
DATE OF DEPOSIT: September 28, 2006

EV817341425US

MS Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF TRANSMITTAL
PURSUANT TO 37 CFR § 41.37

Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal received by The United States Patent and Trademark Office on **July 31, 2006.**

☐   Applicant(s) has previously claimed small entity status under 37 CFR § 41.37 .

☐   Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR § 1.27 as:

       ☐   an Independent Inventor

       ☐   a Small Business Concern

       ☐   a Nonprofit Organization.

☐   Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4) to extend the time for response to the Office Action of   to and through comprising an extension of the shortened statutory period of   month(s).

	SMALL ENTITY		NOT SMALL ENTITY	
	RATE	FEE	RATE	FEE
☒ APPEAL BRIEF FEE	$250	$	$500	$500.00
☐ ONE MONTH EXTENSION OF TIME	$60	$	$120	$
☐ TWO MONTH EXTENSION OF TIME	$225	$	$450	$
☐ THREE MONTH EXTENSION OF TIME	$510	$	$1020	$
☐ FOUR MONTH EXTENSION OF TIME	$795	$	$1590	$
☐ FIVE MONTH EXTENSION OF TIME	$1080	$	$2160	$
☐ LESS ANY EXTENSION FEE ALREADY PAID	minus	($)	minus	($)
TOTAL FEE DUE		$0		$500.00

☒   The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.

☐   A check in the amount of **$ .00** is attached. Please charge any deficiency or credit any overpayment to Deposit Account No. 23-3050.

☒   Please charge Deposit Account No. 23-3050 in the amount of **$500.00**. This sheet is attached in duplicate.

☒   The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of the fees associated with this communication to Deposit Account No. 23-3050.

Date: September 28, 2006

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DOCKET NO.: 164216.1/MSFT-0275   **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Confirmation No.: **1941**

Rajasekhar Abburi Et Al.

Serial No.: **09/892,318**   Group Art Unit: 2136

Filing Date: **06/27/2001**   Examiner: **Eleni A Shiferaw**

For: **Enforcement Architecture And Method For Digital Rights Management System For Roaming A License To A Plurality Of Users**

                           EXPRESS MAIL LABEL NO: EV817341425US
                           DATE OF DEPOSIT: September 28, 2006

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Alexandria, VA 22313-1450

Sir:

APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 41.37

This brief is being filed in support of Appellant's appeal from the rejections of claims 1, 3-12, 14-17 and 20-26 dated March 29, 2006. A Notice of Appeal was filed on July 28, 2006.

1.   REAL PARTY IN INTEREST

The real party in interest is Microsoft Corporation of Redmond, Washington. This case is assigned to Microsoft Corporation of Redmond, Washington, by assignment recorded June 27, 2001 at Reel 011947, Frame 0192.

2.   **RELATED APPEALS AND INTERFERENCES**

A Pre-Appeal Brief Request for Review was filed on 07/31/2006 to request review of Application No. 09/892,318. A response dated 8/17/2006 was generated. That response concluded that the application remains under appeal because there is at least one actual issue for appeal. The panel has determined the status of the claims remains unchanged from that at the Final Rejection dated 3/29/06 where Claims 1, 3-12, 14-17, and 20-26 are rejected and Claims 2, 13, and 18-19 are cancelled. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review is included in Section 10 of this brief.

3.   STATUS OF CLAIMS

Claims 1, 3-12, 14-17, and 20-26 are pending in the application. Claims 2, 13, and 18-19 stand cancelled by Appellant. All pending claims stand finally rejected as a result of the March 29, 2006 Final Office Action. No claims were amended in the Final Response submitted May 26, 2006. An Advisory Action dated 6/20/2006 was generated by the Examiner.

The cancelled claims were cancelled in a Final Response dated June 30, 2005 to a Final Office Action dated May 6, 2005. Claim 12, the last amended claim, was amended in a non-final response submitted on January 18, 2006 in response to a non-final Office Action dated October 18, 2005.

Pending Claims 1, 3-12, 14-17, and 20-26 are the subject of this appeal.

4.   STATUS OF AMENDMENTS

All amendments are entered in the pending Claims 1, 3-12, 14-17, and 20-26. The last amendment was made to Claim 12 in a non-final response submitted on January 18, 2006 in response to a non-final Office Action dated October 18, 2005. That last amendment was entered.

The listing of claims that appears in Section 8 of this brief reflects the status of the claims.

5.   SUMMARY OF CLAIMED SUBJECT MATTER

The following references to page and line numbers in this section refer to the Appellant's originally filed specification. In general, the invention is directed to methods and systems that "roam" a digital license for digital content from one device to a plurality of devices. The "roamed" license is bound to the device targeted for playback of the digital content. As stated on page 6 lines 12-24:

"The present invention provides a roaming service that allows a license to access content to be bound to a plurality of computers. In accordance with the invention, a user may enroll with a license synchronization server, the computing devices that he wants to participate in the roaming service. Typically when a user acquires licensed content, the user will acquire a license to access the content. Typically, the license the user receives is cryptographically bound to the device that receives the license, and is usable only on that device. In accordance with the invention, software that runs on the device contacts a license synchronization server and uploads a copy of the license. The license synchronization server then provides a copy of the license to the user's registered devices. The copies provided to the respective devices are cryptographically bound to those respective devices, rather than to the device that originally received the license." (Page 6 , lines 12-24).

The licenses generated for any devices other than the original or first device are limited in duration. As stated on page 7 lines 3-16 states:

"To control the number of licenses deployed, copies of a license (hereinafter "copy/replacement licenses") distributed to the registered devices by the synchronization server are set to "decay" even if the original license granted usage rights for an indefinite term. That is, each copy/replacement license has a second, relatively short-term expiration date instead of the original license expiration date, so that long-term continued access to content requires periodic contact with the license synchronization server in order to update the expiration date on the copy/replacement license. The second short-term expiration date (hereinafter, "expiry") governs how long the computing device will stay on a list of active registered devices. If a computing device does not connect with a synchronization server between the date the computing device received the copy/replacement license and the time the copy/replacement license expires, the device will be removed from the list of active, registered devices contained within a "device store"." (page 7 lines 3-16).

Additionally, as stated on page 8 lines 4-19:

"In accordance with the invention, to initiate the service, a user connects to the license synchronization server and registers all devices owned by the user that the user wants to roam. Preferably, the user and the list of registered devices may be associated with some type of universal identifier, such as the user's MICROSOFT PASSPORT account. The service imposes a limit on the number of devices a user can register (e.g., five devices at any one time).

After a device is registered, licenses are synchronized with that device whenever the license synchronization server is contacted. When a first registered client device connects to the license server, any new licenses obtained on the first client device since the last synchronization are sent to the license server and any new licenses obtained by another device registered to the user are provided to the first device. As noted above, *the license copies* provided to the client will be set to "decay," and will be cryptographically bound to the particular public/private key pair associated with the client device. Preferably, the provision of licenses (as well as updating of expiration dates) occurs transparently to the user." (page 7, lines 4-19).

Mapping portions of the independent claims to the specification is provided below. Appellant notes that other portions of the specification may also map to the claimed portions. It should be appreciated that the provided citations are simply examples and are not meant as exclusive references to the relevant claim language. In fact, other parts of the specification may be relevant to the determination of the present appeal.

Claim 1 Mapping

Independent Claim 1 recites a method of providing a digital license to at least a second device that is held by a first device. The mapping of The Claim 1 element to the specification is provided in parentheses as follows:

"1.   A method of enabling the use of a digital license on a plurality of devices, said digital license permitting the use of a content item and being bound to a first of said plurality of devices by a first key pair associated with said first device (See page 111, lines 13-25), said method comprising:

receiving a first digital license from said first device, said first digital license associated with a first expiration date (See Figure 23, page 107, lines 8-13, and Figure 26, page 118, lines 2-15);

receiving a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair (See page 108, lines 15-18, and page 130, lines 7-10, and Figures 24, 25);

creating a second digital license bound to said second device using said second key pair, said second digital license being based on said first digital license, (See page 108, lines 3-14, and Figures 24 and 25) wherein said second digital license is set to expire prior to said first expiration date on a second expiration date (See page 118, lines 2-15 and Figure 26) and wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server; (See page 118, lines 17-27 and Figures 24-26) and

transmitting said second digital license to said second device (See page 130, lines 10-12).

Claim 12 Mapping

Independent Claim 12 recites a method of roaming a digital license to a plurality of devices. The mapping of The Claim 12 element to the specification is provided in parentheses as follows:

"12.   A method of roaming a digital license onto a plurality of devices, said roamed digital license enabling the use of a content item on a plurality of devices, (See page 111, lines 13-25) comprising:

receiving a first digital license cryptographically bound to a first device, said first digital license having a first set of terms (See Figure 23, page 107, lines 8-13, and Figure 26, page 118, lines 2-15);

creating a second digital license cryptographically bound to said first device, said second digital license being based on said first digital license, said second digital license having a second set of terms different from said first set of terms, (See page 108, lines 3-14, and Figures 24 and 25) wherein said second digital license is set to expire prior to said first digital license on a second expiration date, (See page 118, lines 2-15 and Figure 26) and wherein failure of said first device to contact a license synchronization server prior to said

second expiration date results in removal of said first device from a registration store on said license synchronization server; (See page 118, lines 17-27 and Figures 24-26) and

transmitting said second license to said first device. (See page 130, lines 10-12)

Claim 17 Mapping

Independent Claim 17 recites a method of providing a digital license to a plurality of devices. The mapping of The Claim 12 element to the specification is provided in parentheses as follows:

"17.   A method of enabling the use of a first digital license on a plurality of devices, said first digital license permitting the use of a content item and being bound to a first of said plurality of devices by a first key pair associated with said first device, (See page 111, lines 13-25) said method comprising:

sending, to a license synchronization server, a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair; (See page 108, lines 3-9, and page 130, lines 5-7, and Figures 24, 25) and

receiving, from said license synchronization server, a second digital license bound to said second device by said second key pair, said second digital license being based on said first digital license, (See page 130, lines 7-10, and Figures 24, 25);wherein said second digital license is set to expire before said first digital license, (See page 118, lines 2-15 and Figure 26) and wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server. (See page 118, lines 17-27 and Figures 24-26)

Claim 24 Mapping

Independent Claim 24 recites a system for roaming a digital license to a plurality of devices. The mapping of The Claim 24 element to the specification is provided in parentheses as follows:

"24.   A system for roaming a digital license to a plurality of computing devices (Figures 24-25) comprising:

a receiving module which receives over a computer network:

from a first of said plurality of computing devices, a first digital license which permits the use of a content item and is bound to said first of said plurality of computing devices by a first key pair associated with said first of said plurality of computing devices; (See page 108, lines 6-8) and

a second key pair associated with a second of said plurality of computing devices different from said first of said plurality of computing devices, said second key pair being different from said first key pair; (See page 129 line 17- page 130 line 15)

a license-rewriting module which uses said second key pair to create a second digital license based on said first digital license, said second digital license being bound to said second device, said second digital license expiring before said first digital license, (page 111, line 13 through page 112 line 4 and Figure 25) wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server; (See page 118, lines 17-27 and Figures 24-26) and

a transmitting module for transmitting said second license to said second device. (See page 130, lines 10-12)

6.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I.   Whether the Examiner has demonstrated that claims 1, 5, 8, 16-17, 23-24, and 26 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Story, Jr. et al. (U.S. Publ No. US 2002/0046181 A1) in view of Benson et al. (U.S. Patent No. 6,678,665 B1) and Hurtado et al. (U.S. Patent No. 6,418,421 B1) and in further view of Biddle et al. (U.S Patent Publication No. US 2002/0107809 A1).

II.   Whether the Examiner has demonstrated that claims 3-4, 6-7, 9-11, 20-22 and 25 are unpatentable under 35 U.S.C. 103(a) as being obvious over Story, Jr. et al. (U.S. Publ No. US 2002/0046181 A1) in view of Benson et al. (U.S. Patent No. 6,678,665 B1) and further in view of Yang et al. (Publ. No. US 2002/0194008 A1), and Hurtado et al. (U.S. Patent No. 6,418,421 B1), and Biddle et al. (US Publ No. 2002/0107809 A1).

III.   Whether the Examiner has properly presented and demonstrated that claims 12, and 14-15 are unpatentable under 35 U.S.C. 103(a) as being obvious over Hurtado et al. (U.S. Patent No. 6,418,421 B1), in view of Biddle et al. (US Publ No. 2002/0107809 A1) for the first time in the Final Office Action.

7.   ARGUMENT

Argument I.   The issue is whether the Examiner has demonstrated that claims 1, 5, 8, 16-17, 23-24, and 26 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Story, Jr. et al. (U.S. Publ No. US 2002/0046181 A1) in view of Benson et al. (U.S. Patent No. 6,678,665 B1) and Hurtado et al. (U.S. Patent No. 6,418,421 B1) and in further view of Biddle et al. (U.S Patent Publication No. US 2002/0107809 A1).

The Final Office Action rejection dated 3/29/06 rejects independent Claims 1, 17, and 24 and their dependent Claims 5, 8, 16, 23, and 26 under 35 U.S.C §103(a) using the combination of Story et al. (Story), Benson et al. (Benson), Hurtado et al. (Hurtado), and Biddle et al. (Biddle). Appellant submits that (1) the combination of Story, Benson, Hurtado, and Biddle is impermissible according to the MPEP, and (2) the all claim elements are not found in the cited art.

1.   An impermissible combination of references is in the 35 U.S.C §103(a) rejection of Claims 1, 5, 8, 16-17, 23-24, and 26.

The teachings of the combination of references of Story and Hurtado are not sufficient to render the claims prima facie obvious per MPEP §2143.01 Part VI because the addition of Hurtado to Story impermissibly changes the principle of operation of Story by separating the digital license from the digital content as widely taught and thoroughly claimed in Story.

MPEP §2143.01 Part VI states that a proposed modification cannot change the principle of operation of a reference in a 35 U.S.C. §103 rejection. Specifically, Part VI states:

> "If the proposed modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In Re Ratti, 270 F.2D 810, 123 USPQ 349 (CCPA 1959)." (MPEP §2143.01 Part VI.)

Appellant submits that the combination of Story, Benson, Hurtado, and Biddle must be an operable combination that considers all of the teachings of the cited references. Appellant submits that it is not proper to ignore a teaching in one of the references that changes the principle of operation of another reference in the combination. Given a teaching

in one reference that changes the principle of operation in a combined reference, then the combination of the references is impermissible under MPEP §2143.01 Part VI. Appellant believes that changing a principle of operation of one reference in order to force an incompatible set of references together to form a 35 U.S.C §103(a) rejection impermissibly ignores the actual teachings of the references.

         Story teaches in the Abstract:

             "A method and apparatus for digital content license management is disclosed that provides one or more license management devices that manage licenses for playback of digital content. The license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set corresponds to the cardinality of the license. The license is also included in digital content that the license authorizes for playback. ..." (Story, Abstract)

         Appellant notes that Story teaches that the digital license is included in the digital content is also present in paragraphs 0005, 0051, 0052, Figures 6 and 7, and Claims 1, 11, and 21 as follows:

         "[0005] A method and apparatus for digital content license management is disclosed. A license having a cardinality is created by a license management device. The license has an associated cardinality. The license is stored in one or more playback devices. The number of playback devices associated having playback licenses is based, at least in part, on the cardinality. *The license is included in digital content.* The playback devices are enabled to playback the digital content including the license. In one embodiment, a single license can be used to authorize playback from multiple content providers." (Story, Paragraph 0005)

         "[0051] The license is communicated to a content provider or other party that distributes digital content at 640. *The content provider includes the license in digital content at 650. In one embodiment, the content provider stores one or more licenses in digital content targeted for playback devices having corresponding licenses.* Alternatively, the content provider can include a list of all current licenses in the digital content. *In another embodiment, the license management device causes the*

license to be stored in the digital content in a manner similar to storage of the license in the set of playback devices described above.

[0052] The one or more playback devices having the license are authorized to play the digital content at 660. In one embodiment, the licenses stored in the playback devices and *the licenses stored in the digital content are encrypted* to prevent copying and/or signed to verify the origin of the license." (Story, Paragraphs 0051-0052)

Appellant notes that Figures 6 and 7 at steps 650 and 730 respectively both state that the " License is included in digital content" (See Story, Figures 6-7). Claims 1, 11, and 21 claim the element of storing the license in the digital content as follows:

"A method of managing digital content licenses, the method comprising: creating a first license having a first cardinality, the license created by a license management device; storing the first license in a first set of playback devices in response to a command from the license management device, wherein the first set of playback devices is determined based, at least in part, on the first cardinality; *storing the first license in first digital content;* and authorizing playback of the first digital content with the first set of playback devices." (Story, Claim 1)

"A machine-readable medium having stored thereon sequences of instructions that when executed by one or more processors cause the one or more processors to: create a first license with a license management device, the first license having a first cardinality; store the first license in a first set of playback devices in response to a command from the license management device, wherein the first set of playback devices is determined based, at least in part, on the first cardinality; *store the first license in first digital content;* and authorize playback of the first digital content with the first set of playback devices." (Story, Claim 11)

An apparatus for digital license management, the apparatus comprising: means for creating a first license in a license management device, the first license having a first cardinality; means for storing the first license in a first set of playback devices in response to a command from the license management device; *means for storing the first license in first digital content*; and means for authorizing playback of the first digital content with the first set of playback devices. (Story, Claim 21)

Appellant notes that the storing of the license into the digital content is not only taught often in Story, it is also an element in every independent claim of Story as shown above. Appellant concludes that this is a major operational principle of Story. In contrast, Hurtado has a wholly incompatible teaching of keeping the digital license and digital content separate.

Hurtado et al. teaches a system for tracking usage of digital content on user devices (See Hurtado, Abstract). Figure 1D of Hurtado contains separately numbered items 147 and 148 labeled a "License SC" (Secure Container) and a "Content SC". Figure 6 depicts similar separate entities in items 602 (Content SC) and 660 (License SC). The digital content is transferred in a Content SC and the digital license is contained in a License SC. Appellant notes that theses two SCs are separate entities, each having a separate reference designators and separate labels.

Hurtado teaches at col. 26, lines 55-65 how the Content SC and License SC are used. Hurtado states:

"After receiving the License SC(s) 660, the End-User Device(s) 109 decrypts the Symmetric Key 623 and the Transaction Data 642 previously received from the Clearinghouse(s) 105 and requests the Content SC(s) 630 (step 607) from a Content Hosting Site(s) 111. Upon arrival of the Content SC(s) 630 (step 608), the End-User Device(s) 109 decrypts the Content 113 using the Symmetric Key 623 (step 609), and passes the Content 113 and the Transaction Data 642 to the other layers for license watermarking, copy/play coding, scrambling, and further Content 113 processing as described previously for FIG. 5." (Hurtado, col. 26, lines 55-65).

Appellant submits that Hurtado teaches that the separate entities of the Content SC and the License SC are not combined. In fact, Hurtado at col. 26 lines 55-65 teaches that after receiving the License SC, the end user device requests the separate Content SC. Then, upon arrival of the Content SC, the end user device decrypts the content. Appellant submits that this teaching provides evidence that the Content SC and the License SC are purposefully separate items and are treated separately by the user device and are not combined. This

contrasts directly with the above-discussed teachings of Story wherein the digital license is included in the digital content itself.

Accordingly, Appellant submits Hurtado et al. teaches that the separate entities of the Content SC and the License SC are not combined. Specifically, the License SC is not stored in the Content SC as is taught in the specification and Claims 1, 11, and 21 of Story. It was noted above that the storage of the digital license into the digital content was so important to Story that the combination of license into the content was not only recited multiple times in the specification, but it was also placed in every independent claim of the Story invention. Appellant submits that the addition of Hurtado, with its separate license and digital content aspect, into the invention of Story, with its claimed combined license and digital content, changes the principle of operation of Story because the modification of Story by Hurtado changes the fundamental way the end user device of Story has to store and use digital content and a digital license.

Story uses a principle that includes a digital license inside the digital content. The addition of Hurtado to Story breaks the combined license and content principle relied upon by Story and forces Story to change its principle of operation. Also, the architecture teaching of Hurtado cannot store the license into the digital content as required by the principle of Story. Accordingly, the addition of Hurtado to Story impermissibly changes the principle of operation of Story. The addition of Hurtado to Story is sufficient to dramatically change the principle of operation of Story and renders the present 35 U.S.C. §103 (a) rejection impermissible according to MPEP §2143.01 Part VI.

The Final Office Action dated 3/29/06 also adds the teachings of Benson and Biddle to the combination of Story and Hurtado to form the rejection of Claims 1, 5, 8, 16-17, 23-24, and 26. (Office action dated 3/29/06, page 4, item 3). However, the addition of Benson and Biddle to the combination of Story and Hurtado does not diminish the impermissible effect of Hurtado dramatically changing the principle of operation of Story. As a result, any combination that includes Story and Hurtado is impermissible as a combination of references for a 35 U.S.C §103 (a) rejection under MPEP §2143.02, Part VI.

In as much as the architecture of Hurtado keeps the Content SC and the License SC as separate items, yet Story teaches and claims digital content and digital licenses are specifically combined, the two references are fundamentally incompatible and thus not combinable under MPEP §2143.01 Part VI because the combination impermissibly changes the operation of Story and thus cannot be a viable combination for purposes of establishing a prima facie case of obviousness under 35 U.S.C. §103(a). (Refer to Applicant response dated 5/26/2006. pages 8-10).

Accordingly, Applicant respectfully submits that the 35 U.S.C. §103 (a) rejection does not represent a valid prima facie case of obviousness. Applicant submits that this applies to the 35 U.S.C. §103 (a) rejection of independent Claims 1, 5, 8, 16-17, 23-24, and 26. The use of Story and Hurtado is impermissible according to MPEP §2143.01 Part VI. Thus, Claims 1, 5, 8, 16-17, 23-24 and 26 patentably define over the cited art. Based on the arguments outlining the impermissible combination of Story and Hurtado, a withdrawal of the 35 U.S.C §103(a) rejection of Claims 1, 5, 8, 16-17, 23-24 and 26 is earnestly requested.

2. The all claim elements are not found in the references cited in the 35 U.S.C §103(a) rejection of Claims 1, 5, 8, 16-17, 23-24, and 26.

The Final Office Action dated 3/29/06 states on pages 4-5 item 3, in relevant part: "As per claim 1, Story teaches a method of enabling the use of a digital license on a plurality of devices … said digital license permitting the use of a content item and being bound to a first of said plurality of devices by a first key pair associated with said first device (Story Page 1 par. 0016; encrypted digital license are stored in playback devices), said method comprising:

… receiving a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair (Story Page 4 Claim no. 3; second digital license is stored in the second device; and Page 4 par. 0052, digital license stored in the device is encrypted and it is obvious that the second device receives the second key pair different from the first key pair because it would prevent an authorized copy of digital content); creating a second digital license bound to said second device using said second key pair . (Story Page 4 Claim no. 3; creating a second license and second license is stored in the second device; Page 4 par. 0052

license stored in different devices are encrypted it is obvious that different key pair is used if license is encrypted because it would prevent an authorized copying of digital content); ..." (Office Action dated 3/29/2006).

Appellant submits that Story does not teach the independent Claim 1 elements of: "receiving a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair" and "creating a second digital license bound to said second device using said second key pair, said second digital license being based on said first digital license". Specifically, Story fails to teach any key pair.

The Final Office Action dated 3/29/06 refers to portions of Story that purport to teach the use of first and second key pairs in the elements referenced above. Specifically, the 3/29/06 Office Action cites paragraphs 0016, Claim 3, and paragraph 0052 of Story to teach those elements of Claim 1 mentioned above.

Story, in paragraph 0016, states:
"[0016] The present invention provides one or more license management devices that manage licenses for playback of digital content. The license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license. In one embodiment, the license management device causes the license to be stored in the set of playback devices by using one or more digitally signed and/or encrypted commands." (Story, para. 0016).

Claim 3 of Story recites:
"The method of claim 1 further comprising: creating a second license having a second cardinality, the license created by the license management device; storing the second license in a second set of playback devices, wherein the second set of playback devices is determined based, at least in part, on the second cardinality, and further wherein at least one playback device belongs to the first set and to the second set; storing the second license in second digital content; authorizing playback of the second digital content with the second set of playback devices."

And paragraph 0052 of Story states:

"[0052] The one or more playback devices having the license are authorized to play the digital content at 660. In one embodiment, the licenses stored in the playback devices and the licenses stored in the digital content are encrypted to prevent copying and/or signed to verify the origin of the license."

Upon examination of paragraph 0016 of Story, Appellant concludes that Story teaches a license management device that create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. And, in one embodiment of Story, the license management device causes the license to be stored in the set of playback devices by using either or both of a digitally signature or an encrypted command. Appellant notes that Story does not teach "being bound to a first of said plurality of devices by a first key pair associated with said first device" as recited in Claim 1 because Story does not teach a key pair. Thus, the reference fails to teach the related Claim 1 element.

Upon examination of Claim 3 of Story, Appellant concludes that Story claims at least creating a second license having a second cardinality where the cardinality defines the number of licenses permitted, storing the second license in a second set of playback devices, wherein the second set of playback devices is determined based, at least in part, on the second cardinality, and wherein at least one playback device belongs to the first set and to the second set; storing the second license in second digital content, and then authorizing playback of the second digital content with the second set of playback devices. Appellant notes that Story does not teach "receiving a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair" or "creating a second digital license bound to said second device using said second key pair" as recited in Appellant's Claim 1 because Story Claim 3 does not recite a key pair. Thus the reference fails to teach the related Claim 1 element.

Further, upon examination of paragraph 0052 of Story, Appellant concludes that Story teaches a that the licenses stored in the digital content are encrypted to prevent copying and/or signed to verify the origin of the license. Appellant notes that Story does not teach "creating a second digital license bound to said second device using said second key pair" as

recited in Claim 1 because Story does not teach a key pair. Thus, the reference fails to teach the related Claim 1 element.

Appellant notes that Story in paragraphs 0016, 0052, and Claim 3 teaches "encryption" but fails to teach the use of a first key pair, a second key pair, licenses bound to devices using a key pair, or creating a second digital license using a second key pair.

Page 5 of the Final Office Action dated 3/29/06, concerning the applicability of Story to Claim 1, states in part:

"Page 4 par. 0052 license stored in different devices are encrypted it is obvious that different key pair is used if license is encrypted because it would prevent an authorized copying of digital content". (Office Action page 5).

However, it is not apparent to the Appellant that Story contemplates the use of a different "encryption" scheme using different key pairs for different playback devices because Story does not even teach the use of keys. It is well known in the art that there are many different types of "encryption". The Office Action dated 3/29/06 impermissibly assumes a teaching of key pairs and other relationships that are simply not expressed in the teachings of Story.

In addition, Appellant can find no teaching in Story that a different encryption scheme is used between any of the playback devices. Story teaches generating a different cardinality (number of licenses), but not a different encryption tied to each of the playback devices. Accordingly, Appellant concludes that there is no teaching of separate encryption mechanisms for playback devices involved in Story. Also, since encryption in Story is not defined, Appellant believes that the "encryption" teaching in Story need not be accomplished using key pairs at all. This is in distinction to appellant's Claim 1 which recites elements including a different key pair for a first and second device.

Appellant notes that pending independent Claims 17 and 24 also contain the elements of a first key pair, a second key pair, wherein the key pairs differ, and wherein the keys are used to bind licenses to devices. All of these elements are notably missing from Story because Story merely teaches "encryption" in paragraph 0052 and does not teach the

existence of any "key pair". Therefore, Story fails to teach all of the recited elements of independent Claims 1, 17, and 24.

MPEP §21423.03 provides that all claim limitations must be taught or suggested by stating:

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981,180 USPQ 580 (CCPA 1974)." (MPEP §2143.03)

Since all the elements of independent Claims 1, 5, 8, 16-17, 23-24, and 26 are not taught or suggested by the prior art, then a prima facie case of obviousness is not established under 35 U.S.C §103(a) per MPEP 4123.03.

Summary of Argument I:

Appellant submits that the Final Office Action dated 3/29/06 fails to establish a prima facie case of obviousness under 35 U.S.C §103(a) against Claims 1, 5, 8, 16-17, 23-24, and 26 because:

(1) The combination of Story et al. (Story), Benson et al. (Benson), Hurtado et al. (Hurtado), and Biddle et al. (Biddle) is an impermissible combination under MPEP 4123.02 Part VI because the addition of Hurtado to Story impermissibly changes the principle of operation of Story. Whereas Story purposefully always combines a digital license with digital content, the addition of Hurtado changes that explicitly claimed principle by separating the license and content into two separate secure containers. Thus, any combination of cited art containing Story and Hurtado is impermissible as a combination under 35 U.S.C §103(a). Although the Final Office action dated 3/29/06 tries to use selected teachings of Story and Hurtado, a proper rejection cannot ignore all of the teachings of the cited art especially if the teaches are incompatible as in the case of Hurtado and Story.

(2) Not all of the elements are taught in the 35 U.S.C §103(a) rejection against Claims 1, 5, 8, 16-17, 23-24, and 26. Specifically, the elements of a first key pair, a second key pair, and a binding of a key pair to a selected license for a device are not taught in Story as asserted by the Final Office Action dated 3/29/06. Story affirmatively teaches "encryption" but fails to teach or suggest anything about key pairs or the relationship of key pairs to either licenses or devices such as is recited in independent Claims 1, 17, and 24. Since all elements

are not taught or suggested by the combination of Story, Benson, Hurtado, and Biddle, then a prima facie case of obviousness is not established under MPEP 2143.03.

Thus, Appellant finds two separate and independent grounds for relief of the 35 U.S.C §103(a) rejection of Claims 1, 5, 8, 16-17, 23-24, and 26. First, the combination of Story, Benson, Hurtado, and Biddle is impermissible because of the incompatible combination of Story and Hurtado. In that incompatibility, Story teaches a combined digital license and content whereas Hurtado uses separate digital license and digital content. The combination is impermissible because Hurtado changes the principle of operation of Story. Any combination of such incompatible teachings is prohibited under MPEP §2143.02 Part VI. The second independent ground of relief is that not all elements of independent Claims 1, 17, and 24 are taught in the cited references. Story is used as the reference that teaches key pair related elements yet Story is absent such a specific teaching. As such, since all element are not taught by the cited reference, a prima facie case of obviousness is not established per MPEP §2143.03. Accordingly, Appellant requests a withdraw of the 35 U.S.C §103(a) rejections of Claims 1, 5, 8, 16-17, 23-24, and 26 and a Notice of Allowance for these claims as they patentably define over the prior art.

Argument II. The issue is whether the Examiner has demonstrated that claims 3-4, 6-7, 9-11, 20-22 and 25 are unpatentable under 35 U.S.C. 103(a) as being obvious over Story, Jr. et al. (U.S. Publ No. US 2002/0046181 A1) in view of Benson et al. (U.S. Patent No. 6,678,665 B1) and further in view of Yang et al. (Publ. No. US 2002/0194008 A1), and Hurtado et al. (U.S. Patent No. 6,418,421 B1), and Biddle et al. (US Publ No. 2002/0107809 A1).

Appellant notes that the rejection to Claims 3-4, 6-7, 9-11, 20-22 and 25 is based on the same combination of references as the rejection in Arguments Section I above with the addition of the reference Yang et al. (Yang). Also, Appellant notes that Claims 3-4, 6-7, and 9-11 are ultimately dependent on independent Claim 1 which is argued above in Part I of this section. Also, Claims 20-2 are dependent on Claim 17 which is argued above in Part I of this section. Also, Claim 25 is dependent upon independent Claim 24 which is argued above in Part I of this section.

Appellant submits that since independent Claims 1, 17, and 24 patentably define over the cited art because (1) the combination of Story, Benson, Hurtado, and Biddle is impermissible according to MPEP §2143.02 Part VI, and (2) the all claim elements are not found in the cited art and thus a prima facie case of obviousness is not established per MPEP §2143.03, then the addition of Yang to the impermissible combination of Story and Hurtado still results in an impermissible combination which cannot be used to a to establish a prima facie case of obviousness under 35 U.S.C §103(a).

Summary of Argument II.

Appellant submits that the Final Office Action dated 3/29/06 fails to establish a prima facie case of obviousness under 35 U.S.C §103(a) against Claims 3-4, 6-7, 9-11, 20-22 and 25 because:

(1) The combination of Story et al. (Story), Benson et al. (Benson), Hurtado et al. (Hurtado), and Biddle et al. (Biddle) is an impermissible combination under MPEP 4123.02 Part VI because the addition of Hurtado to Story impermissibly changes the principle of operation of Story as discussed herein above.

(2) Not all of the elements are taught in the 35 U.S.C §103(a) rejection against Claims 3-4, 6-7, 9-11, 20-22 and 25. Specifically, the elements of a first key pair, a second key pair, and a binding of a key pair to a selected license for a device in relevant independent Claims 1, 17, and 24 are not taught in Story as asserted by the Final Office Action dated 3/29/06. Story affirmatively teaches "encryption" but fails to teach or suggest anything about key pairs or the relationship of key pairs to either licenses or devices such as is recited in independent Claims 1, 17, and 24. Since all elements are not taught or suggested by the combination of Story, Benson, Hurtado, Biddle, and Yang, then a prima facie case of obviousness is not established under MPEP 2143.03.

(3) Claims 3-4, 6-7, 9-11, 20-22 and 25 are dependent on relevant independent Claims 1, 17, and 24 and thus are allowable by virtue of the allowability of these respective independent claims.

Accordingly, Appellant finds three grounds for relief of the 35 U.S.C §103(a) rejection of Claims 3-4, 6-7, 9-11, 20-22 and 25. First, the combination of Story, Benson, Hurtado, and Biddle is impermissible because of the incompatible and thus impermissible combination of Story and Hurtado according to MPEP §2143.02 Part VI as described in detail Part I of this section. The second independent ground of relief is that not all elements of

independent Claims 1, 17, and 24 are taught in the cited references and thus a prima facie case of obviousness is not established per MPEP §2143.03 for these independent claims as discussed in Part I of this section. And third, Claims 3-4, 6-7, 9-11, 20-22 and 25 are dependent on independent Claims 1, 17, and 24 and thus are allowable by virtue of the allowability of these respective independent claims. Accordingly, Appellant requests a withdraw of the 35 U.S.C §103(a) rejections of Claims 3-4, 6-7, 9-11, 20-22 and 25 and a Notice of Allowance for these claims as they patentably define over the prior art.

Argument III.   The issue is whether the Examiner has properly presented and demonstrated that Claims 12, and 14-15 are unpatentable under 35 U.S.C. 103(a) as being obvious over Hurtado et al. (U.S. Patent No. 6,418,421 B1), in view of Biddle et al. (US Publ No. 2002/0107809 A1) for the first in the Final Office Action.

Appellant first notes that, in the non-final Office Action dated 10/18/2006, Claims 12, and 14-15 were rejected under 35 U.S.C §103 (a) as being obvious under the combination of five (5) references: Story, Jr. et al. (U.S. Publ No. US 2002/0046181 A1), Benson et al. (U.S. Patent No. 6,678,665 B1), Yang et al. (Publ. No. US 2002/0194008 A1), Hurtado et al. (U.S. Patent No. 6,418,421 B1), and Biddle et al. (US Publ No. 2002/0107809 A1).

Appellant, in the non-final response, amended Claim 12 to include an additional limitation of "said second digital license being based on said first digital license". As a result of this added limitation, the Examiner modified the 35 U.S.C §103(a) rejection of Claims 12, 14-15 which listed the five (5) afore-mentioned references, to a 35 U.S.C §103(a) rejection having only two (2) references; Hurtado and Biddle. Appellant submits that the first time this 35 U.S.C §103(a) rejection of Claims 12, 14-15 was introduced was in the Final Office Action dated 3/29/2006. Appellant did not have a chance to address this new rejection prior to the Final Office Action dated 3/29/06. Appellant believes that just as removal of one inventor from a set of many inventor results in a different inventive entity, so removal of three references from a 35 U.S.C §103 rejection containing five references creates a new rejection.

In addressing Claims 12 and 14-15, Page 19 of the Final Office Action dated 3/29/06 states:

> "Hurtado fails to explicitly teach the amended subject matter wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server. However Biddle teaches wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server (Biddle par. 0114 and claim 14; if a user device fails to renew a license with an expiration date, the user device is terminated/removed from getting services/content from license server)." (Office Action dated 3/29/06, Page 19).

Appellant agrees that Hurtado fails to explicitly teach "wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server" as recited in independent Claim 12. However, Appellant disagrees that Biddle teaches the missing element.

Biddle teaches a system and method of license management. Specifically, Biddle in paragraph 0114 teaches:

> "[0114] Once the registration process is complete, the license manager performs an HTML post operation to send the registration information back to the website to retrieve the license file. The license manager performs this, and other operations, for example, in response to API calls made by the application. After the appropriate checks are successfully completed by the license monitor using the information in the license file, the application may then be permitted to run. In an exemplary aspect, the expiration date for the free trial may be predetermined by the vendor 40 and the application will run until that date. When the authorized term expires, the license monitor initializes the license manager with an API call and displays the appropriate webpages allowing the user 30 to obtain a new license through the subscription process. If the user 30 does not obtain a subscription and a new license file, the licensing API calls will return an "expired" status back to the application which will

then terminate after displaying an error message to the user 30. In addition, the licensing code is able to determine if the current date on the user computer 30 has been altered in an attempt to artificially extend the free trial. Other security countermeasures now known or hereafter derived by those skilled in the art may be used to subvert attempts to bypass the expiration date feature." (Biddle, Paragraph 0114).

Appellant notes that Biddle in paragraph 00014 teaches a license manager that supervises and monitors the expiration date for the free trial of software. This is a single license. Biddle then teaches in paragraph 0114 a technique to thwart an attempt to artificially extend the free trial. Appellant notes that there is no teaching of a second license needed to express the elements of "wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server" as recited in Claim 12. Biddle teaches aspects related to a free trial expiration period of a single license and a method to stop extension of the free trial period for that single license. Claim 12 recites no such free trial on a single license limitation.

Biddle at Claim 14 recites:

"14. The method for managing licensing data according to claim 1, wherein said modification of the terms corresponding to at least one license stored in said client license datastore further comprises a method step selected from the group consisting of deleting a license, expiring a license, terminating a license, renewing a license, manually subscribing a license, automatically subscribing a license, transferring a license, abandoning a license, reactivating a license, and any combination thereof." (Biddle, Claim 14)

Appellant notes that claim 14, fails to teach a second device. Although modification of a license is taught, Claim 14 fails to disclose the element of "wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server" as recited in Appellant's Claim 12 because Biddle Claim 14 fails to explicitly discuss a second device which contacts a license synchronization server prior to a second expiration date.

Since all elements of Claims 12, 14-15 are not taught in the combination of Hurtado and Biddle, then the stated combination cannot render obvious Claims 12, 14-15 according to MPEP §2143.03. Accordingly, Appellant requests a withdraw of the 35 U.S.C §103(a) rejections of Claims 12, 14-15 and a Notice of Allowance for these claims as they patentably define over the prior art.

Summary of Argument III.

Appellant submits that the first time the combination of Hurtado and Biddle was presented to Appellant was in a Final Office Action dated 3/29/06. Appellant had not previously had an opportunity to address this particular combination of the cited references before the 3/29/06 Final Office Action.

Notwithstanding the emergence of the new rejection combination of Hurtado and Biddle at a Final Office Action, Appellant submits that the 3/29/06 Final Office Action fails to establish a prima facie case of obviousness under 35 U.S.C §103(a) against Claims 12, 14-15 because:

Not all of the elements are taught in the 35 U.S.C §103(a) rejection against Claims 12, 14-15. Specifically, the elements of "wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server" as recited in independent Appellant's Claim 12 are not found in the cited reference of Biddle and are not found in Hurtado by Examiner admission in Final Office Action dated 3/29/06. Since all elements are not taught or suggested by the combination of Hurtado and Biddle, then a prima facie case of obviousness is not established under MPEP 2143.03.

8.   CLAIMS APPENDIX

1.   (Previously Presented)   A method of enabling the use of a digital license on a plurality of devices, said digital license permitting the use of a content item and being bound to a first of said plurality of devices by a first key pair associated with said first device, said method comprising:

receiving a first digital license from said first device, said first digital license associated with a first expiration date;

receiving a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair;

creating a second digital license bound to said second device using said second key pair, said second digital license being based on said first digital license, wherein said second digital license is set to expire prior to said first expiration date on a second expiration date and wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server; and

transmitting said second digital license to said second device.

2.   (Cancelled)

3.   (Previously Presented)   The method of claim 1, wherein said act of creating the second digital license includes adding the second expiration date to said second digital license, said second expiration date occurring earlier in time than said first expiration date.

4.   (Original)   The method of claim 3, wherein said second expiration date comprises a specified offset from a date on which said act of transmitting said second digital license occurs.

5.   (Original)   The method of claim 1, further comprising:

creating a third digital license bound to said first device; and

transmitting said third license to said first device.

6.   (Previously Presented)   The method of claim 5, wherein said third digital license includes a third expiration date.

7.   (Previously Presented)   The method of claim 6, wherein said third expiration date comprises a specified offset from a date on which said act of transmitting said third license occurs.

8.   (Original)   The method of claim 1, further comprising the act of limiting the number of said plurality of devices.

9.   (Previously Presented)   The method of claim 1, wherein said method further comprises the act of periodically refreshing said second digital license with one or more third digital licenses based on said first digital license, each of said third digital licenses including a third expiration date different from said first expiration date.

10.   (Original)   The method of claim 1, further comprising revoking said second digital license.

11.   (Original)   The method of claim 10, further comprising re-assigning said second digital license to a third of said plurality of devices after said revocation of said second digital license.

12.   (Previously Presented)   A method of roaming a digital license onto a plurality of devices, said roamed digital license enabling the use of a content item on a plurality of devices, comprising:

        receiving a first digital license cryptographically bound to a first device, said first digital license having a first set of terms;

        creating a second digital license cryptographically bound to said first device, said second digital license being based on said first digital license, said second digital license having a second set of terms different from said first set of terms, wherein said second digital license is set to expire prior to said first digital license on a second expiration date, and wherein failure of said first device to contact a license synchronization server prior to said second expiration date results in removal of said first device from a registration store on said license synchronization server; and

                transmitting said second license to said first device.

13.   (Cancelled)

14.   (Previously Presented)   The method of claim 12, wherein said second expiration date comprises a date which is a specified offset from a date on which said act of creating said second digital license occurs.

15.   (Original)   The method of claim 12, further comprising the act of periodically replacing said second license on said first device.

16.   (Original)   A computer-readable medium containing computer-executable instructions for performing the method of claim 1.

17.   (Previously Presented)   A method of enabling the use of a first digital license on a plurality of devices, said first digital license permitting the use of a content item and being bound to a first of said plurality of devices by a first key pair associated with said first device, said method comprising:

        sending, to a license synchronization server, a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair; and

        receiving, from said license synchronization server, a second digital license bound to said second device by said second key pair, said second digital license being based on said first digital license, wherein said second digital license is set to expire before said first digital license, and wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server.

18.   (Cancelled)

19.   (Cancelled)

20.   (Original)   The method of claim 17, wherein said second expiration date comprises a specified offset from a date on which said act of receiving said second digital license occurs.

21.   (Previously Presented)   The method of claim 17, wherein said second digital license has a set of license terms, and wherein said method further comprises periodically receiving a replacement of said second digital license, wherein each of the periodic replacements has said set of license terms and a second expiration date different from said first expiration date.

22.   (Original)   The method of claim 17, wherein said second digital license is revocable.

23   (Original)   A computer-readable medium containing computer-executable instructions for performing the method of claim 17.

24.   (Previously Presented)   A system for roaming a digital license to a plurality of computing devices comprising:
          a receiving module which receives over a computer network:

          from a first of said plurality of computing devices, a first digital license which permits the use of a content item and is bound to said first of said plurality of computing devices by a first key pair associated with said first of said plurality of computing devices; and

          a second key pair associated with a second of said plurality of computing devices different from said first of said plurality of computing devices, said second key pair being different from said first key pair;

          a license-rewriting module which uses said second key pair to create a second digital license based on said first digital license, said second digital license being bound to said second device, said second digital license expiring before said first digital license, wherein failure of said second device to contact a license synchronization server prior to said second

expiration date results in removal of said second device from a registration store on said license synchronization server; and

a transmitting module for transmitting said second license to said second device.

25.   (Original)   The system of claim 24, further comprising:

a transmitting module which periodically transmits a refreshed second license to said second device.

26.   (Original)   The system of claim 24, further comprising:

a module which limits the number of said plurality of devices.

9.   EVIDENCE APPENDIX

Appellant attaches the following items generated by the PTO and relied upon by the Appellant:

(1) Non-Final Office Action dated 10/18/2005

(2) Final Office Action dated 3/29/2006.

Regular

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,318	06/27/2001	Rajasekhar Abburi	164216.1/MSFT-0275	1941

			EXAMINER
41505	7590	10/18/2005	SHIFERAW, ELENI A

WOODCOCK WASHBURN LLP
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PHILADELPHIA, PA 19103

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 10/18/2005

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OCT 2 0 2005

Woodcock Washburn

Please find below and/or attached an Office communication concerning this application or proceeding.

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DOCKET DEPT
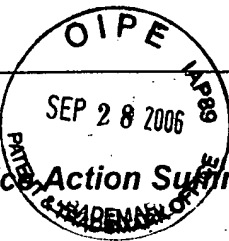WWKMN

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OCT 2 5 2005

Mary Ann Devine
Woodcock Washburn

PTO-90C (Rev. 10/03)

Application No.	Applicant(s)
09/892,318	ABBURI ET AL.
Examiner	Art Unit	
Eleni A. Shiferaw	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 August 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) <u>1-26</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on August 5, 2005 has been entered.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1, 5, 8, 16-17, 23-24, and 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Story, JR. et al. (Story, Pub. No.: US 2002/0046181 A1) in view of Benson et

al. (Benson, Patent No.: US 6,678,665 B1), Hurtado et al. (Hurtado, US 6,418,421 B1), and

Biddle et al. (Biddle, Pub. No.: US 2002/0107809 A1).

As per claim 1, Story teaches a method of enabling the use of a digital license on a plurality of

devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is

stored in one or more playback devices or computers), said digital license permitting the use of a

content item and being bound to a first of said plurality of devices by a first key pair associated

with said first device (Story Page 1 par. 0016; encrypted digital license are stored in playback

devices), said method comprising:

receiving a first digital license from said first device (Story Page 2 par. 0022; receiving a

digital license from license management server);

receiving a second key pair associated with a second of said plurality of devices, said

second key pair being different from said first key pair (Story Page 4 Claim no. 3; second digital

license is stored in the second device; and Page 4 par. 0052, digital license stored in the device is

encrypted and it is obvious that the second device receives the second key pair different from the

first key pair because it would prevent an authorized copy of digital content);

creating a second digital license bound to said second device using said second key pair

(Story Page 4 Claim no. 3; creating a second license and second license is stored in the second

device; Page 4 par. 0052 license stored in different devices are encrypted it is obvious that

different key pair is used if license is encrypted because it would prevent an authorized copying

of digital content); and

transmitting said second digital license to said second device (Story Page 4 Claim no. 3;

digital license is transmitted from license management server and stored in the second device);

Story does not explicitly teach said second digital license being based on said first digital

license;

However Benson teaches generating a public and private key pair and the first key pair is

associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to employ the teachings of Benson with in the system of Story because it

would allow to locate a certificate that holds the associated digital signature public keying

material and then the software vendor may potentially execute some administrative action

(Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill

in the art at the time of the invention was made to apply the teachings of Benson with in the

system of Story because it would locate the first digital license and provide service to a user to

render the digital content on different computer devices without purchasing a duplicate license.

The combination of Story and Benson do not explicitly teach wherein said second digital

license is set to expire prior to said first expiration date on the second expiration date;

However Hurtado teaches digital license associated with expiration date, and wherein

said second digital license is set to expire prior to said first expiration date on the second

expiration date (Hurtado col. 11 lines 38-43, col. 10 lines 6-55, and col. 9 lines 29-31, and col.

23 lines 23-42; user condition specifies whether or not a secondary copy of the content is

allowed, the number of secondary copies, and whether or not the content may be copied to an

external portable device of the user, and also Hurtado teaches extending/adding or narrowing the

user's conditions);

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to modify the teachings of Hurtado within the combination system of

Story and Benson by set the modified first digital license to expire prior to the first license

because it would allow to give the user more options of term conditions and the user would pay

less for having the modified first digital license set to expire before the first license.

Story, Benson and Hurtado disclose all the subject matter as described above. Story,

Benson, and Hurtado fail to explicitly teach the amended subject matter wherein failure of said

second device to contact a license synchronization server prior to said second expiration date

results in removal of said second device from a registration store on said license synchronization

server.

However Biddle teaches wherein failure of said second device to contact a license

synchronization server prior to said second expiration date results in removal of said second

device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the

license agreement is expired. One skilled in the art would have been motivated to do so to

control illegal usage of content and require users to make payments when usage expires.

As per claim 17, Story teaches a method of enabling the use of a first digital license on a

plurality of devices (Story Page 3 par. 0039, Fig. 5; digital license created by license

management device is stored in one or more playback devices), said first digital license

permitting the use of a content item and being bound to a first of said plurality of devices by a

first key pair associated with said first device (Story Page 1 par. 0016; encrypted digital license

are stored in playback devices), said method comprising:

sending, to a license synchronization server, a second key pair associated with a second

of said plurality of devices, said second key pair being different from said first key pair (Story

Page 4 Claim no. 3; second digital license is transmitted from license management server and stored in the second device; and Page 4 par. 0052, digital license stored in the device is encrypted and it is obvious at the time of the invention was made that the second device receives the second key pair different from the first key pair because it would prevent an authorized copy of digital content); and

receiving, from said license synchronization server, a second digital license bound to said second device by said second key pair (Story Page 4 Claim no. 3; receiving a second license and storing a second license on the second device; Page 4 par. 0052 license stored in different devices are encrypted it is obvious that different key pair is used if license is encrypted because it would prevent an authorized copying of digital content),

Story does not explicitly teach said second digital license being based on said first digital license

However Benson teaches generating a public and private key pair and the first key pair is associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Benson with in the system of Story because it would allow to locate a certificate that holds the associated digital signature public keying material and then the software vendor may potentially execute some administrative action (Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Benson with in the system of Story because it would locate the first digital license and provide service to a user to render the digital content on different computer devices without purchasing a duplicate license.

The combination of Story and Benson do not explicitly teach wherein said second digital

license is set to expire before said first digital license;

However Hurtado teaches wherein said second digital license is set to expire before said

first digital license (Hurtado col. 11 lines 38-43, col. 10 lines 6-55, and col. 9 lines 29-31; a

digital content with original and modified copy of the original certificate is provided to the user's

different devices, and col. 23 lines 23-42; user condition specifies whether or not a secondary

copy of the content is allowed, the number of secondary copies, and whether or not the content

may be copied to an external portable device of the user, and also Hurtado teaches

extending/adding or narrowing the user's conditions);

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to modify the teachings of Hurtado within the combination system of

Story and Benson by set the modified first digital license to expire prior to the first license

because it would allow to give the user more options of term conditions and the user would pay

less for having the modified first digital license set to expire before the first license.

Story, Benson and Hurtado disclose all the subject matter as described above. Story,

Benson, and Hurtado fail to explicitly teach the amended subject matter wherein failure of said

second device to contact a license synchronization server prior to said second expiration date

results in removal of said second device from a registration store on said license synchronization

server.

However Biddle teaches wherein failure of said second device to contact a license

synchronization server prior to said second expiration date results in removal of said second

device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the

license agreement is expired. One skilled in the art would have been motivated to do so to

control illegal usage of content and require users to make payments when usage expires.

As per claim 24, Story teaches a system for roaming a digital license to a plurality of computing

devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is

stored in one or more playback devices) comprising:

a receiving module which receives over a computer network (Story Page 3 par. 0036;

playback device module receives over a computer network):

from a first of said plurality of computing devices (Story Page 3 par. 0039,

Fig. 5; digital license created by license management device is stored in one or more playback

devices), a first digital license which permits the use of a content item and is bound to said first

of said plurality of computing devices by a first key pair associated with said first of said

plurality of computing devices (Story Page 1 par. 0016; encrypted digital license are stored in

playback devices); and

a second key pair associated with a second of said plurality of computing

devices different from said first of said plurality of computing devices, said second key pair

being different from said first key pair (Story Page 4 Claim no. 3, Page 4 par. 0052; an encrypted

second digital license associated with a second of said plurality of computing devices is created

it is obvious that different key pair is used for the second encrypted digital license because it

would prevent an authorized copying of digital content);

a license-rewriting module which uses said second key pair to create a

second digital license, said second digital license being bound to said second device (Story Page

2 par. 0028-0030, Page 4 Claim no. 3, and Page 4 par. 0052; license management module

rewriting a second encrypted digital license to a second device); and

a transmitting module for transmitting said second license to said second

device (Story Page 2 par. 0032, and Page 4 Claim no. 3; license management module

transmitting said second license to said second device);

Story does not explicitly teach said second digital license being based on said first digital

license;

However Benson teaches generating a public and private key pair and the first key pair is

associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to employ the teachings of Benson with in the system of Story because it

would allow to locate a certificate that holds the associated digital signature public keying

material and then the software vendor may potentially execute some administrative action

(Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill

in the art at the time of the invention was made to apply the teachings of Benson with in the

system of Story because it would locate the first digital license and provide service to a user to

render the digital content on different computer devices without purchasing a duplicate license.

The combination of Story and Benson do not explicitly teach wherein second digital license expiring before said first digital license;

However Hurtado teaches wherein second digital license expiring before said first digital license (Hurtado col. 11 lines 38-43, col. 10 lines 6-55, and col. 9 lines 29-31; a digital content with original and modified copy of the original certificate is provided to the user's different devices, and col. 23 lines 23-42; user condition specifies whether or not a secondary copy of the content is allowed, the number of secondary copies, and whether or not the content may be copied to an external portable device of the user, and also Hurtado teaches extending/adding or narrowing the user's conditions);

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Hurtado within the combination system of Story and Benson by set the modified first digital license to expire prior to the first license because it would allow to give the user more options of term conditions and the user would pay less for having the modified first digital license set to expire before the first license.

Story, Benson and Hurtado disclose all the subject matter as described above. Story, Benson, and Hurtado fail to explicitly teach the amended subject matter wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server.

However Biddle teaches wherein failure of said second device to contact a license synchronization server prior to said second expiration date results in removal of said second device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the

license agreement is expired. One skilled in the art would have been motivated to do so to

control illegal usage of content and require users to make payments when usage expires.

As per claim 5, Story, Benson, Hurtado, and Biddle teach all the subject matter as described

above. In addition Story teaches the method, further comprising: creating a third digital license;

and transmitting said third license to said first device (Story Page 1 par. 16; creating a digital

license and transmitting and storing it in one or more devices); and

Benson the first key pair is associated with the second key pair (Benson Col. 12 lines 16-

23) that reads on a third digital license bound to said first device. The rational for combining are

the same as claim 1 above.

As per claim 8, Story, Benson, Hurtado, and Biddle teach all the subject matter as described

above. In addition Story teaches the method, further comprising the act of limiting the number of

said plurality of devices (Story Page 3 par. 0039; digital license can be stored in one or mere

devices).

As per claim 16 and 23, Story, Benson, Hurtado, and Biddle teach all the subject matter as

described above. In addition Story teaches a computer-readable medium containing computer-executable instructions for performing the method (Story Page 2 par. 0028-0030).

As per claim 26, Story, Benson, Hurtado, and Biddle teach all the subject matter as described above. In addition Story teaches the method, further comprising: a module which limits the number of said plurality of devices (Story Page 3 par. 0039; digital license can be stored in one or mere devices).

4.   Claims 2-4, 6-7, 9-15, 18-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Story, JR. et al. (Story, Pub. No.: US 2002/0046181 A1) in view of Benson et al. (Benson, Patent No.: US 6,678,665 B1), Yang et al. (Yang, Pub. No.: US 2002/0194008 A1) and Hurtado et al. (Hurtado, US 6,418,421 B1), and Biddle et al. (Biddle, Pub. No.: US 2002/0107809 A1).

As per claim 12, Story teaches a method of roaming a digital license onto a plurality of devices (Story Page 3 par. 0039, Fig. 5 No. 550, and 560; digital license is distributed to different devices), said roamed digital license enabling the use of a content item on a plurality of devices (Story Abstract), comprising:

receiving a first digital license cryptographically bound to a first device (Story Page 4 Claim no. 1, and Page 4 par. 0052; receiving an encrypted digital license by a first device;

transmitting said second license to said first device (Story Page 4 Claim no. 3; digital license is transmitted from license management server and stored in the second device)

Story does not explicitly teach creating a second digital license cryptographically bound

to said first device,

However Benson teaches generating a public and private key pair and associating the

second key pair with the first key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to employ the teachings of Benson with in the system of Story because it

would allow to locate a certificate that holds the associated digital signature public keying

material and then the software vendor may potentially execute some administrative action

(Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill

in the art at the time of the invention was made to apply the teachings of Benson with in the

system of Story because it would locate the first digital license and provide service to a user to

render the digital content on different computer devices without purchasing a duplicate license.

Story and Benson do not explicitly teach said first digital license having a first set of

terms;

said second digital license having a second set of terms different from said first

set of terms;

However Yang discloses a software license with a set of terms that reads on said first

digital license having a first set of terms (Yang Abstract);

Yang also teaches the possibility of storing information pertaining to multiple

contracts in a system with each contract potentially having different terms that reads on said

second digital license having a second set of terms different from said first set of terms (Yang

Page 5 par. 0045);

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to employ the teachings of Yang with in the combination system of

Story and Benson because it would allow to specify the digital license contract rules and govern

how the digital license contract is to be fulfilled (Yang Page 4 par. 0039). Therefore it would

have been obvious to one ordinary skill in the art at the time of the invention was made to have

different set of terms in a first digital license and a second digital license because it would allow

a periodic contact with a license synchronization server in order to update the expiration date on

the copy/replacement license, and governs how long the computing device will stay on a list of

active registered devices.

The combination of Story, Benson, and Yang do not explicitly teach wherein said second

digital license is set to expire prior to said first digital license on second expiration date;

However Hurtado teaches creating a second digital license cryptographically bound to

said first device and wherein said second digital license is set to expire prior to said first digital

license on second expiration date (Hurtado col. 11 lines 38-43, col. 10 lines 6-55, and col. 9 lines

29-31; a digital content with original and modified copy of the original certificate is provided to

the user's different devices, and col. 23 lines 23-42; user condition specifies whether or not a

secondary copy of the content is allowed, the number of secondary copies, and whether or not

the content may be copied to an external portable device of the user, and also Hurtado teaches

extending/adding or narrowing the user's conditions);

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to modify the teachings of Hurtado within the combination system of

Story, Benson, and Yang by set the modified first digital license to expire prior to the first

license because it would allow to give the user more options of term conditions and the user

would pay less for having the modified first digital license set to expire before the first license.

Story, Benson, Yang and Hurtado disclose all the subject matter as described above.

Story, Benson, and Hurtado fail to explicitly teach the amended subject matter wherein failure of

said second device to contact a license synchronization server prior to said second expiration

date results in removal of said second device from a registration store on said license

synchronization server.

However Biddle teaches wherein failure of said second device to contact a license

synchronization server prior to said second expiration date results in removal of said second

device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the

license agreement is expired. One skilled in the art would have been motivated to do so to

control an illegal usage of content and require users to make payments when usage expires.

As per claim 2, and 18; Story, Benson; Yang, Hurtado, and Biddle teach all the subject matter as

described above. In addition Yang teaches the method, duration of a digital license that reads on

wherein said first digital license includes a first expiration date (Yang Page 1 par. 0007, and 10

par. 0091). Therefore it would have been obvious to one having ordinary skill in the art at the

time the invention was made to employ the teachings of Yang with in the combination system

because it would allow to select digital license contract terms and satisfy user needs (Yang Page

4 par. 0039). Therefore it would have been obvious to one ordinary skill in the art at the time of

the invention was made to include expiration date on the first digital license because it would

limit time to access digital content.

As per claim 3, and 19, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as

described above. In addition Yang teaches the method, wherein said act of creating a second

digital license includes adding a second expiration date to said second digital license (Yang Page

1 par. 0007, and10 par. 0091), said second expiration date occurring earlier in time than said first

expiration date (Yang Page 5 par. 0045); Therefore it would have been obvious to one having

ordinary skill in the art at the time the invention was made to employ the teachings of Yang with

in the combination system of Story and Benson because it would allow to specify the digital

license contract rules and govern how the digital license contract is to be fulfilled (Yang Page 4

par. 0039). Therefore it would have been obvious to one ordinary skill in the art at the time of the

invention was made to have second expiration date occurring earlier in time than the first

expiration date because it would allow a periodic contact with a license synchronization server in

order to update the expiration date on the copy/replacement license, and governs how long the

computing device will stay on a list of active registered devices.

As per claim 4, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as

described above. In addition Yang teaches the method, wherein said second expiration date

comprises a specified offset from a date on which said act of transmitting said second digital license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 6, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang teaches a method, duration of a digital license that reads on wherein said third digital license includes a first expiration date (Yang Page 1 par. 0007, and 10 par. 0091). The rational for combining are the same as claim 2 above.

As per claim 7, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, wherein said first expiration date comprises a specified offset from a date on which said act of transmitting said third license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 9, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, wherein said second digital license includes a first expiration date (Yang Page 4 par. 0038), and each of said third digital licenses including a second expiration date different from said first expiration date (Yang Page 5 par. 0045). The rational for combining are the same as claim 12 above.

Benson teaches a method for digital license, the first key pair associated with the second key pair that reads on a second digital license with one or more third digital licenses based on said first digital license (Benson Col. 12 lines 17-23),

Yang teaches wherein said method further comprises the act of periodically refreshing said second digital license with one or more third digital licenses (Yang Page 5 par. 0051-Page 6 par. 0052; duration of time for digital license is given, digital license can be canceled, and digital license can be re-placed). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to end or cancel a digital license authorization (Yang Page 6 par. 0052)

As per claim 10 and 22, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, further comprising revoking said second digital license (Yang Page 5 par. 0051-Page 6 par. 0052). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to cancel to re-assign a digital license authorization (Yang Page 6 par. 0052).

As per claim 11, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, further comprising re-assigning said second digital license to a third of said plurality of devices after said revocation of said second digital license (Yang Page 5 par. 0051-Page 6 par. 0052). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to re-assign a digital license to a user (Yang Page 6 par. 0052).

As per claim 13, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, wherein said first set of terms includes a first expiration date, and wherein said second set of terms includes a second expiration date different from said first expiration date (Yang Fig. 5C No. 534). The rational for combining are the same as claim 12 above.

As per claim 14, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, wherein said second expiration date comprises a date which is a specified offset from a date on which said act of creating said second digital license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 15, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, further comprising the act of periodically replacing said second license on said first device (Yang Page 6 par. 0052; canceling digital license and re-assigning it).

As per claim 20, Story, Benson, Yang, and Hurtado teach all the subject matter as described above. In addition Yang, wherein said second expiration date comprises a specified offset from a date on which said act of receiving said second digital license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 21, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, wherein said second digital license has a set of license terms and a first expiration date (Yang Page 4 par. 0038), and wherein said method further comprises periodically receiving a replacement of said second digital license, wherein each of the periodic replacements has said set of license terms (Page 5 par. 0046) and a second expiration date different from said first expiration date (Yang Page 5 par. 0045). The rational for combining are the same as claim 12 above.

As per claim 25, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, further comprising: a transmitting module which periodically transmits a refreshed second license to said second device (Yang Page 6 par. 0052). The rational for combining are the same as claim 9 above.
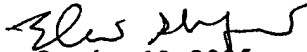
Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Eleni Shiferaw
October 13, 2005

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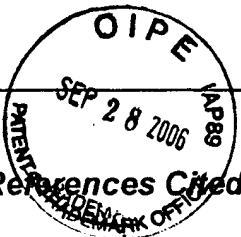
Notice of References Cited

	Application/Control No.	Applicant(s)/Patent Under Reexamination
	09/892,318	ABBURI ET AL.
	Examiner	Art Unit	Page 1 of 1
	Eleni A. Shiferaw	2136	

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-2002/0046181	04-2002	STORY et al.	705/59
	B	US-6,678,665	01-2004	Benson et al.	705/51
	C	US-2002/0194008	12-2002	Yang et al.	705/1
	D	US-2002/0065781 a1	05-2002	Hillegass et al.	705/59
	E	US-6,223,291 b1	04-2001	Puhl et al.	726/28
	F	US-6,772,133 b1	08-2004	Kambayashi et al.	705/57
	G	US-2002/0007454	01-2002	TARPENNING et al.	713/156
	H	US-6,418,421 B1	07-2002	Hurtado et al.	705/54
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	J	US-			
	K	US-			
	L	US-			
	M	US-			

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09/892,318	06/27/2001	Rajasekhar Abburi	164216.1/MSFT-0275	1941

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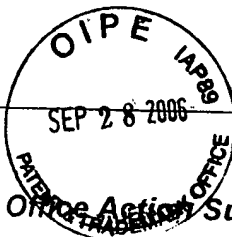Please find below and/or attached an Office communication concerning this application or proceeding.

FINAL REJECTION

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/892,318	ABBURI ET AL.
	Examiner	Art Unit	
	Eleni A. Shiferaw	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _18 January 2006_.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1,3-12,14-17 and 20-26_ is/are pending in the application.

   4a) Of the above claim(s) _2, 13, and 18-19_ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1,3-12,14-17 and 20-26_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some *   c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to amended claim 12, and pending claims 1, 3-12, 14-17, and 20-26, filed on 01/18/2006, have been fully considered but they are not persuasive. The examiner would like to point out that this action is made final (see, MPEP 706.07a).

Applicant argues that:

independent claims 1, 12, 17, and 24 are not taught by none of the references whether alone or in combination to support the limitation wherein "said second digital license being based on said first digital license;" and

dependent claims are allowable based upon their dependency on allowable claims 1, 12, 17, and 24.

Regarding applicant's arguments concerning references failure to disclose "said second digital license being based on said first digital license", the examiner respectfully disagrees with the applicant's contention and would like to draw the Applicant's attention to Applicant's disclosure pages 107-110 wherein said "...**each copy of original license** provided to each device 1302a, 1302b, 1302c is **cryptographically bounded** to the respective device to which the license is downloaded, rather than being cryptographically bound to the device..." and also Applicant claims on independent claim 12 wherein "...creating a **second digital license cryptographically bounded to said first device...**, **said second digital license being based on said first digital license**", claim 17, "...**a second key pair associated with a second of said**

plurality of devices...., said second digital license being based on said first digital license",

and claim 24, **"...a second key pair to create a second digital license based on said first digital license..., said second digital license being based on said first digital license"**

Examiner rejects the argued subject matter where in said a second digital license being based on said first digital license based on the disclosure that Applicant provided.

That is the second digital license is cryptographically bounded to the first digital license and/or the cryptography first pair of key is associated with the second pair of key as disclosed in Bensons patent col. 11 lines 66-col. 12 lines 2. It is clear that Bensons does in fact teach the argued subject matter wherein said second digital license being based on said first digital license. If applicant has a different definition than the specified disclosure, the difference needs to be clearly defined in the claims and/or provided in the disclosure.

Hurtado et al. also discloses providing/rendering digital content and licenses to user multiple devices (Abstract, col. 23 lines 43-63). Licenses provided to multiple devices of a single user are related/associated and/or the second license provided to second device of a user is based on the first license provided to the first device of the user (col. 12 lines 62-col. 13 lines 63).

examiner disagrees with applicant's argument for dependency. Based on the arguments set forth by the examiner, for arguments above, the dependent claims stand rejected.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 5, 8, 16-17, 23-24, and 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Story, JR. et al. (Story, Pub. No.: US 2002/0046181 A1) in view of Benson et

al. (Benson, Patent No.: US 6,678,665 B1), Hurtado et al. (Hurtado, US 6,418,421 B1), and

Biddle et al. (Biddle, Pub. No.: US 2002/0107809 A1).

As per claim 1, Story teaches a method of enabling the use of a digital license on a plurality of

devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is

stored in one or more playback devices or computers), said digital license permitting the use of a

content item and being bound to a first of said plurality of devices by a first key pair associated

with said first device (Story Page 1 par. 0016; encrypted digital license are stored in playback

devices), said method comprising:

receiving a first digital license from said first device (Story Page 2 par. 0022; receiving a

digital license from license management server);

receiving a second key pair associated with a second of said plurality of devices, said

second key pair being different from said first key pair (Story Page 4 Claim no. 3; second digital

license is stored in the second device; and Page 4 par. 0052, digital license stored in the device is

encrypted and it is obvious that the second device receives the second key pair different from the

first key pair because it would prevent an authorized copy of digital content);

creating a second digital license bound to said second device using said second key pair .

(Story Page 4 Claim no. 3; creating a second license and second license is stored in the second

device; Page 4 par. 0052 license stored in different devices are encrypted it is obvious that

different key pair is used if license is encrypted because it would prevent an authorized copying

of digital content); and

transmitting said second digital license to said second device (Story Page 4 Claim no. 3;

digital license is transmitted from license management server and stored in the second device);

Story does not explicitly teach said second digital license being based on said first digital

license;

However Benson teaches generating a public and private key pair and the first key pair is

associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to employ the teachings of Benson with in the system of Story because it

would allow to locate a certificate that holds the associated digital signature public keying

material and then the software vendor may potentially execute some administrative action

(Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill

in the art at the time of the invention was made to apply the teachings of Benson with in the

system of Story because it would locate the first digital license and provide service to a user to

render the digital content on different computer devices without purchasing a duplicate license.

The combination of Story and Benson do not explicitly teach wherein said second digital

license is set to expire prior to said first expiration date on the second expiration date;

However Hurtado teaches digital license associated with expiration date, and wherein

said second digital license is set to expire prior to said first expiration date on the second

expiration date (Hurtado col. 11 lines 38-43, col. 10 lines 6-55, and col. 9 lines 29-31, and col.

23 lines 23-42; user condition specifies whether or not a secondary copy of the content is

allowed, the number of secondary copies, and whether or not the content may be copied to an

external portable device of the user, and also Hurtado teaches extending/adding or narrowing the

user's conditions);

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to modify the teachings of Hurtado within the combination system of

Story and Benson by set the modified first digital license to expire prior to the first license

because it would allow to give the user more options of term conditions and the user would pay

less for having the modified first digital license set to expire before the first license.

Story, Benson and Hurtado disclose all the subject matter as described above. Story,

Benson, and Hurtado fail to explicitly teach the amended subject matter wherein failure of said

second device to contact a license synchronization server prior to said second expiration date

results in removal of said second device from a registration store on said license synchronization

server.

However Biddle teaches wherein failure of said second device to contact a license

synchronization server prior to said second expiration date results in removal of said second

device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the

license agreement is expired. One skilled in the art would have been motivated to do so to

control illegal usage of content and require users to make payments when usage expires.

As per claim 17, Story teaches a method of enabling the use of a first digital license on a

plurality of devices (Story Page 3 par. 0039, Fig. 5; digital license created by license

management device is stored in one or more playback devices), said first digital license

permitting the use of a content item and being bound to a first of said plurality of devices by a

first key pair associated with said first device (Story Page 1 par. 0016; encrypted digital license

are stored in playback devices), said method comprising:

sending, to a license synchronization server, a second key pair associated with a second

of said plurality of devices, said second key pair being different from said first key pair (Story

Page 4 Claim no. 3; second digital license is transmitted from license management server and

stored in the second device; and Page 4 par. 0052, digital license stored in the device is

encrypted and it is obvious at the time of the invention was made that the second device receives

the second key pair different from the first key pair because it would prevent an authorized copy

of digital content); and

receiving, from said license synchronization server, a second digital license bound to said

second device by said second key pair (Story Page 4 Claim no. 3; receiving a second license and

storing a second license on the second device; Page 4 par. 0052 license stored in different

devices are encrypted it is obvious that different key pair is used if license is encrypted because it

would prevent an authorized copying of digital content),

Story does not explicitly teach said second digital license being based on said first digital

license

However Benson teaches generating a public and private key pair and the first key pair is

associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to employ the teachings of Benson with in the system of Story because it

would allow to locate a certificate that holds the associated digital signature public keying

material and then the software vendor may potentially execute some administrative action

(Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill

in the art at the time of the invention was made to apply the teachings of Benson with in the

system of Story because it would locate the first digital license and provide service to a user to

render the digital content on different computer devices without purchasing a duplicate license.

The combination of Story and Benson do not explicitly teach wherein said second digital

license is set to expire before said first digital license;

However Hurtado teaches wherein said second digital license is set to expire before said

first digital license (Hurtado col. 11 lines 38-43, col. 10 lines 6-55, and col. 9 lines 29-31; a

digital content with original and modified copy of the original certificate is provided to the user's

different devices, and col. 23 lines 23-42; user condition specifies whether or not a secondary

copy of the content is allowed, the number of secondary copies, and whether or not the content

may be copied to an external portable device of the user, and also Hurtado teaches

extending/adding or narrowing the user's conditions);

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to modify the teachings of Hurtado within the combination system of

Story and Benson by set the modified first digital license to expire prior to the first license

because it would allow to give the user more options of term conditions and the user would pay

less for having the modified first digital license set to expire before the first license.

Story, Benson and Hurtado disclose all the subject matter as described above. Story,

Benson, and Hurtado fail to explicitly teach the amended subject matter wherein failure of said

second device to contact a license synchronization server prior to said second expiration date

results in removal of said second device from a registration store on said license synchronization

server.

However Biddle teaches wherein failure of said second device to contact a license

synchronization server prior to said second expiration date results in removal of said second

device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the

license agreement is expired. One skilled in the art would have been motivated to do so to control illegal usage of content and require users to make payments when usage expires.

As per claim 24, Story teaches a system for roaming a digital license to a plurality of computing devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is stored in one or more playback devices) comprising:

a receiving module which receives over a computer network (Story Page 3 par. 0036; playback device module receives over a computer network):

from a first of said plurality of computing devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is stored in one or more playback devices), a first digital license which permits the use of a content item and is bound to said first of said plurality of computing devices by a first key pair associated with said first of said plurality of computing devices (Story Page 1 par. 0016; encrypted digital license are stored in playback devices); and

a second key pair associated with a second of said plurality of computing devices different from said first of said plurality of computing devices, said second key pair being different from said first key pair (Story Page 4 Claim no. 3, Page 4 par. 0052; an encrypted second digital license associated with a second of said plurality of computing devices is created it is obvious that different key pair is used for the second encrypted digital license because it would prevent an authorized copying of digital content);

a license-rewriting module which uses said second key pair to create a

second digital license, said second digital license being bound to said second device (Story Page 2 par. 0028-0030, Page 4 Claim no. 3, and Page 4 par. 0052; license management module rewriting a second encrypted digital license to a second device); and

a transmitting module for transmitting said second license to said second device (Story Page 2 par. 0032, and Page 4 Claim no. 3; license management module transmitting said second license to said second device);

Story does not explicitly teach said second digital license being based on said first digital license;

However Benson teaches generating a public and private key pair and the first key pair is associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Benson with in the system of Story because it would allow to locate a certificate that holds the associated digital signature public keying material and then the software vendor may potentially execute some administrative action (Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Benson with in the system of Story because it would locate the first digital license and provide service to a user to render the digital content on different computer devices without purchasing a duplicate license.

The combination of Story and Benson do not explicitly teach wherein second digital license expiring before said first digital license;

However Hurtado teaches wherein second digital license expiring before said first digital license (Hurtado col. 11 lines 38-43; col. 10 lines 6-55, and col. 9 lines 29-31; a digital content

with original and modified copy of the original certificate is provided to the user's different

devices, and col. 23 lines 23-42; user condition specifies whether or not a secondary copy of the

content is allowed, the number of secondary copies, and whether or not the content may be

copied to an external portable device of the user, and also Hurtado teaches extending/adding or

narrowing the user's conditions);

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to modify the teachings of Hurtado within the combination system of

Story and Benson by set the modified first digital license to expire prior to the first license

because it would allow to give the user more options of term conditions and the user would pay

less for having the modified first digital license set to expire before the first license.

Story, Benson and Hurtado disclose all the subject matter as described above. Story,

Benson, and Hurtado fail to explicitly teach the amended subject matter wherein failure of said

second device to contact a license synchronization server prior to said second expiration date

results in removal of said second device from a registration store on said license synchronization

server.

However Biddle teaches wherein failure of said second device to contact a license

synchronization server prior to said second expiration date results in removal of said second

device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the license agreement is expired. One skilled in the art would have been motivated to do so to control illegal usage of content and require users to make payments when usage expires.

As per claim 5, Story, Benson, Hurtado, and Biddle teach all the subject matter as described above. In addition Story teaches the method, further comprising: creating a third digital license; and transmitting said third license to said first device (Story Page 1 par. 16; creating a digital license and transmitting and storing it in one or more devices); and

Benson the first key pair is associated with the second key pair (Benson Col. 12 lines 16-23) that reads on a third digital license bound to said first device. The rational for combining are the same as claim 1 above.

As per claim 8, Story, Benson, Hurtado, and Biddle teach all the subject matter as described above. In addition Story teaches the method, further comprising the act of limiting the number of said plurality of devices (Story Page 3 par. 0039; digital license can be stored in one or more devices).

As per claim 16 and 23, Story, Benson, Hurtado, and Biddle teach all the subject matter as described above. In addition Story teaches a computer-readable medium containing computer-executable instructions for performing the method (Story Page 2 par. 0028-0030).

As per claim 26, Story, Benson, Hurtado, and Biddle teach all the subject matter as described above. In addition Story teaches the method, further comprising: a module which limits the number of said plurality of devices (Story Page 3 par. 0039; digital license can be stored in one or mere devices).

4.   Claims 3-4, 6-7, 9-11, 13, 20-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Story, JR. et al. (Story, Pub. No.: US 2002/0046181 A1) in view of Benson et al. (Benson, Patent No.: US 6,678,665 B1), Yang et al. (Yang, Pub. No.: US 2002/0194008 A1) and Hurtado et al. (Hurtado, US 6,418,421 B1), and Biddle et al. (Biddle, Pub. No.: US 2002/0107809 A1).

As per claim 3, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang teaches the method, wherein said act of creating a second digital license includes adding a second expiration date to said second digital license (Yang Page 1 par. 0007, and 10 par. 0091), said second expiration date occurring earlier in time than said first expiration date (Yang Page 5 par. 0045); Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to specify the digital license contract rules and govern how the digital license contract is to be fulfilled (Yang Page 4 par. 0039). Therefore it would have been obvious to one ordinary skill in the art at the time of the invention was made to have second expiration date occurring earlier in time than the first expiration date because it would allow a periodic contact with a license synchronization server in

order to update the expiration date on the copy/replacement license, and governs how long the computing device will stay on a list of active registered devices.

As per claim 4, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang teaches the method, wherein said second expiration date comprises a specified offset from a date on which said act of transmitting said second digital license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 6, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang teaches a method, duration of a digital license that reads on wherein said third digital license includes a first expiration date (Yang Page 1 par. 0007, and10 par. 0091). The rational for combining are the same as claim 2 above.

As per claim 7, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, wherein said first expiration date comprises a specified offset from a date on which said act of transmitting said third license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 9, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, wherein said second digital license includes a first expiration date (Yang Page 4 par. 0038), and each of said third digital licenses including a second

expiration date different from said first expiration date (Yang Page 5 par. 0045). The rational for combining are the same as claim 12 above.

Benson teaches a method for digital license, the first key pair associated with the second key pair that reads on a second digital license with one or more third digital licenses based on said first digital license (Benson Col. 12 lines 17-23),

Yang teaches wherein said method further comprises the act of periodically refreshing said second digital license with one or more third digital licenses (Yang Page 5 par. 0051-Page 6 par. 0052; duration of time for digital license is given, digital license can be canceled, and digital license can be re-placed). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to end or cancel a digital license authorization (Yang Page 6 par. 0052)

As per claim 10 and 22, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, further comprising revoking said second digital license (Yang Page 5 par. 0051-Page 6 par. 0052). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to cancel to re-assign a digital license authorization (Yang Page 6 par. 0052).

As per claim 11, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as described above. In addition Yang, further comprising re-assigning said second digital license to

a third of said plurality of devices after said revocation of said second digital license (Yang Page

5 par. 0051-Page 6 par. 0052). Therefore it would have been obvious to one having ordinary skill

in the art at the time the invention was made to employ the teachings of Yang with in the

combination system of Story and Benson because it would allow to re-assign a digital license to

a user (Yang Page 6 par. 0052).

.As per claim 13, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as

described above. In addition Yang, wherein said first set of terms includes a first expiration date,

and wherein said second set of terms includes a second expiration date different from said first

expiration date (Yang Fig. 5C No. 534). The rational for combining are the same as claim 12

above.

As per claim 20, Story, Benson, Yang, and Hurtado teach all the subject matter as described

above. In addition Yang, wherein said second expiration date comprises a specified offset from a

date on which said act of receiving said second digital license occurs (Yang Page 4 par. 0038).

The rational for combining are the same as claim 3 above.

As per claim 21, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as

described above. In addition Yang, wherein said second digital license has a set of license terms

and a first expiration date (Yang Page 4 par. 0038), and wherein said method further comprises

periodically receiving a replacement of said second digital license, wherein each of the periodic

replacements has said set of license terms (Page 5 par. 0046) and a second expiration date

different from said first expiration date (Yang Page 5 par. 0045). The rational for combining are

the same as claim 12 above.

As per claim 25, Story, Benson, Yang, Hurtado, and Biddle teach all the subject matter as

described above. In addition Yang, further comprising: a transmitting module which periodically

transmits a refreshed second license to said second device (Yang Page 6 par. 0052). The rational

for combining are the same as claim 9 above.

5.   Claims 12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hurtado et al. (Hurtado, US 6,418,421 B1), in view of Biddle et al. (Biddle, Pub. No.: US

2002/0107809 A1).

Regarding claim 12 Hurtado discloses a method of roaming a digital license onto a plurality of

devices, said roamed digital license enabling the use of a content item on a plurality of devices,

comprising:

        receiving a first digital license cryptographically bound to a first device, said first digital

license having a first set of terms (col. 15 lines 24-32, and col. 23 lines 64-col. 24 lines 67);

        creating a second digital license cryptographically bound to said first device, **said second**

digital license being based on said first digital license (Abstract, col. 23 lines 43-63, and col.

12 lines 62-col. 13 lines 63; Licenses provided to multiple devices of a single user are

related/associated and/or the second license provided to second device of the user is based

on the first license provided to the first device of the user and/or the second license is a

modified copy of the first license of the user), said second digital license having a second set of

terms different from said first set of terms, wherein said second digital license is set to expire

prior to said first digital license on a second expiration date (Hurtado col. 11 lines 38-43, col. 10

lines 6-55, and col. 9 lines 29-31; a digital content with original and modified copy of the

original license certificate is provided to the user's different devices, and col. 23 lines 23-42;

user condition specifies whether or not a secondary copy of the content is allowed, the number of

secondary copies, and whether or not the content may be copied to an external portable device of

the user, and also Hurtado teaches extending/adding or narrowing the user's conditions); and

transmitting said second license to said first device (col. 12 lines 62–col. 13 lines 9).

Hurtado fails to explicitly teach the amended subject matter wherein failure of said

second device to contact a license synchronization server prior to said second expiration date

results in removal of said second device from a registration store on said license synchronization

server.

However Biddle teaches wherein failure of said second device to contact a license

synchronization server prior to said second expiration date results in removal of said second

device from a registration store on said license synchronization server (Biddle par. 0114 and

claim 14; if a user device fails to renew a license with an expiration date, the user device is

terminated/removed from getting services/content from license server).

It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to employ the removal of the second device when failing to renew/contact

the license server before expiration because it is well known to terminate a device when the

license agreement is expired. One skilled in the art would have been motivated to do so to

control illegal usage of content and require users to make payments when usage expires.

As per claim 14, Hurtado further teaches wherein said second expiration date comprises a date

which is a specified offset from a date on which said act of creating said second digital license

occurs (col. 28 lines 15-45).

As per claim 15, Hurtado further teaches teach all the subject matter as described above. In

addition Yang, further comprising the act of periodically replacing said second license on said

first device (col. 23 lines 23-42).

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

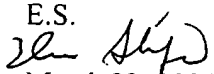Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867.

The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.S.

March 22, 2006

CHRISTOPHER REVAK
PRIMARY EXAMINER

Notice of References Cited

Application/Control No.	Applicant(s)/Patent Under Reexamination
09/892,318	ABBURI ET AL.
Examiner	Art Unit	
Eleni A Shiferaw	2136	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-2002/0046181 a1	04-2002	STORY et al.	705/59
	B	US-6,678,665 b1	01-2004	Benson et al.	705/51
	C	US-2002/0194008 a1	12-2002	Yang et al.	705/1
	D	US-2002/0065781 a1	05-2002	Hillegass et al.	705/59
	E	US-6,223,291 b1	04-2001	Puhl et al.	713/201
	F	US-6,772,133 b1	08-2004	Kambayashi et al.	705/57
	G	US-2002/0007454	01-2002	TARPENNING et al.	713/156
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

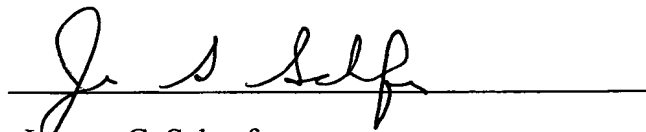| *		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

10.   RELATED PROCEEDINGS APPENDIX

Appellant attaches the following items generated by the PTO and relied upon by the Appellant:

(1)   The Notice of Panel Decision from Pre-Appeal Brief Review is provided herein.
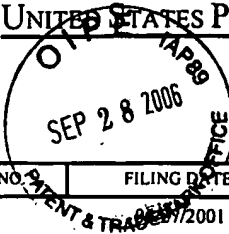
Date: September 28, 2006

_____

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One Liberty Place - 46th Floor
Philadelphia PA 19103
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Facsimile: (215) 568-3439

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,318	06/27/2001	Rajasekhar Abburi	164216.1/MSFT-0275	1941

41505	7590	08/17/2006	

WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER
SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination
[barcode]	09/892,318	ABBURI ET AL.
	Jacques H. Louis-Jacques	Art Unit 2134

Document Code - AP.PRE.DEC

Notice of Panel Decision from Pre-Appeal Brief Review

[barcode]

This is in response to the Pre-Appeal Brief Request for Review filed _07/31/2006_.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

    ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
    ☐ The request does not include reasons why a review is appropriate.
    ☐ A proposed amendment is included with the Pre-Appeal Brief request.
    ☐ Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

    ☒ The panel has determined the status of the claim(s) is as follows:
    Claim(s) allowed: _____.
    Claim(s) objected to: _____.
    Claim(s) rejected: _1, 3-12, 14-17, 20-26_.
    Claim(s) withdrawn from consideration: _2, 13, 18-19_.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) _Jacques H. Louis-Jacques_.

(2) _Joe Dixon_.

(3)_Eleni Shiferaw_.

(4)_____.

[signature stamp: JACQUES LOUIS-JACQUES SUPERVISORY PATENT EXAMINER TECHNOLOGY CENTER 2100]